

### **REMARKS**

Amendment D is hereby provided after careful consideration of the Examiner's comments set forth in the Office Action mailed December 16, 2009. Claims 1-21, 23-52, and 55-60 remain in the application after Amendment D is entered. Reconsideration of the application is respectfully requested in view of the remarks provided herein.

### **The Office Action**

Claims 1-21, 23-52, 55, 57, and 58 stand rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Patent Application Publication No. 2003/0105677 to Skinner.

Claims 56 and 59 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Skinner in view of U.S. Patent Application Publication No. 2003/0055816 to Paine et al.

Claim 60 stands rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Skinner in view of Paine and in further view of U.S. Patent Application Publication No. 2004/0093296 to Phelan et al.

### **The Art Rejections**

#### **Claims 1-21, 23-30, 55, and 58 Patentably Distinguish Over Skinner.**

Independent claim 1 is directed to a method that includes "g) calculating an optimized bid for each advertisement-keyword pair created in d) based at least in part on the corresponding ROAI calculated in f)." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). In order for Skinner to anticipate claim 1, it must teach every element of the claim. See MPEP § 2131. The December 16, 2009 Office Action does not cite any portion of Skinner or any other reference for disclosure of element g) of claim 1.

Based at least on the foregoing, it is submitted that the reasons for rejection of claim 1 are incomplete because citation of a reference in relation to element g) is

**omitted** from the Office Action. Accordingly, the Applicant respectfully submits that rejection of claim 1 under § 102(e) over Skinner is **clear error**. Based on the foregoing, it is submitted that independent claim 1 and claims dependent thereon (e.g., claims 2-21, 23-30, 55, and 58) are currently in condition for allowance.

**Claims 31-39 Patentably Distinguish Over Skinner.**

Independent claim 31 is directed to an apparatus that includes “a bid determination system in communication with the advertisement-keyword selection system for calculating an optimized bid for each advertisement-keyword pair based at least in part on the corresponding ROAI.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros.* In order for Skinner to anticipate claim 31, it must teach every element of the claim. See MPEP § 2131. The December 16, 2009 Office Action uses the same reasons for rejection of independent claim 31 as the § 102(e) rejection of claim 1. The Office Action does not cite any portion of Skinner or any other reference for disclosure of element g) of claim 1 or the “calculating an optimized bid” limitation in the “bid determination system” element of claim 31.

Based at least on the foregoing, it is submitted that the reasons for rejection of claim 31 are incomplete because citation of a reference in relation to the “calculating an optimized bid” limitation in the “bid determination system” element is **omitted** from the Office Action. Accordingly, the Applicant respectfully submits that rejection of claim 31 under § 102(e) over Skinner is **clear error**. Based on the foregoing, it is submitted that independent claim 31 and claims dependent thereon (e.g., claims 32-39) are currently in condition for allowance.

**Claims 40 and 41 Patentably Distinguish Over Skinner.**

Independent claim 40 is directed to a method that includes “b) selecting a plurality of candidate publisher web pages, wherein each candidate publisher web page is associated with one or more candidate advertisement selected in a) and includes one or more auctioned advertisement positions; c) creating an advertisement-publisher web page pair for each candidate advertisement selected in a) and each candidate publisher

web page selected in b); d) estimating a click-through rate for each advertisement-publisher web page pair created in c); e) calculating a return on advertising investment (ROAI) for each advertisement-publisher web page pair created in c) based at least in part on the corresponding click-through rate estimated in d); f) calculating an optimized bid for each advertisement-publisher web page pair created in c) based at least in part on the corresponding ROAI calculated in e); and g) automatically submitting the optimized bids calculated in f) to the competitive bidding process for placement of each candidate advertisement selected in a) in at least one publisher web page of the plurality of candidate publisher web pages selected in b).”

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros.* In order for Skinner to anticipate claim 40, it must teach every element of the claim. See MPEP § 2131. The December 16, 2009 Office Action uses the same reasons for rejection of independent claim 40 as the § 102(e) rejection of claim 1. First, the Office Action does not cite any portion of Skinner or any other reference for disclosure of element g) of claim 1 or element f) of claim 40.

Additionally, where elements b)-h) of claim 1 are directed to “candidate keywords,” “advertisement-keyword pairs,” and “placement of a candidate advertisement in a search results list generated in response to a search query for keyword(s) from the candidate keywords,” elements b)-g) of claim 40 are directed to “candidate publisher web pages,” “advertisement-publisher web page pairs,” and “placement of a candidate advertisement in a publisher web page from the candidate publisher web pages.” Notably, the “publisher web page” in claim 40 is fundamentally different from the “keywords” and “search results lists” of claim 1.

Based at least on the foregoing, it is submitted that the reasons for rejection of claim 40 are incomplete because citation of a reference in relation to each of elements b)-g) is **omitted** from the Office Action. Accordingly, the Applicant respectfully submits that rejection of claim 40 under § 102(e) over Skinner is **clear error**. Based on the foregoing, it is submitted that independent claim 40 and claims dependent thereon (e.g., claim 41) are currently in condition for allowance.

**Claims 42-52 Patentably Distinguish Over Skinner.**

Independent claim 42 is directed to a method that includes “a) selecting at least one candidate advertisement associated with the advertiser; b) selecting one or more keywords based at least in part on content of the at least one candidate advertisement selected in a) to optimize the keyword selecting and provide one or more optimized keywords; c) creating an advertisement-keyword pair for each candidate advertisement selected in a) and each optimized keyword selected in b), wherein each advertisement-keyword pair includes one or more optimized keywords; d) calculating an optimized bid for each advertisement-keyword pair created in c) based at least in part on the one or more optimized keywords selected in b); and e) automatically submitting the optimized bids calculated in d) to the competitive bidding process for placement of each candidate advertisement selected in a) in search results lists generated in response to search queries comprising at least one keyword of the one or more optimized keywords selected in b).”

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros.* In order for Skinner to anticipate claim 40, it must teach every element of the claim. See MPEP § 2131. Skinner deals with bidding on auctioned positions in search results lists. While bids for the auctioned positions may be placed by advertiser's, Skinner does not consider the actual listing to be placed in the auctioned position as a variable in the bidding process.

Based at least on the foregoing, Skinner does not disclose or fairly suggest element a)-e) of claim 42 which clearly selects a candidate advertisement (element a)), selects a keyword based on the candidate advertisement (element b)), creates an advertisement-keyword pair (element c)), calculates a bid for an advertisement-keyword pair (element d)), and submits the bid for the advertisement-keyword pair (element e)). Accordingly, the Applicant respectfully submits that rejection of claim 42 under § 102(e) over Skinner is **clear error**. Based on the foregoing, it is submitted that independent claim 42 and claims dependent thereon (e.g., claim 43-52) are currently in condition for allowance.

**Claim 57 Patentably Distinguishes Over Skinner.**

Independent claim 57 is directed to a computer program product that includes a computer usable medium for causing: “v) determination of an optimized bid for each advertisement-keyword pair created in iv).” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros.* In order for Skinner to anticipate claim 57, it must teach every element of the claim. See MPEP § 2131. The December 16, 2009 Office Action uses the same reasons for rejection of independent claim 57 as the § 102(e) rejection of claim 1. The Office Action does not cite any portion of Skinner or any other reference for disclosure of element g) of claim 1 or element v) of claim 57.

Based at least on the foregoing, it is submitted that the reasons for rejection of claim 57 are incomplete because citation of a reference in relation to element v) is **omitted** from the Office Action. Accordingly, the Applicant respectfully submits that rejection of claim 57 under § 102(e) over Skinner is **clear error**. Based on the foregoing, it is submitted that independent claim 57 is currently in condition for allowance.

**Claims 56 and 59 Patentably Distinguishes Over the Combination of Skinner and Paine.**

Claims 56 and 59 depend from independent claim 1. Accordingly, claims 56 and 59 are patentably distinct from the combination of Skinner and Paine for at least the same reasons provided above distinguishing claim 1 from Skinner. Based at least on the foregoing, the Applicant respectfully submits that claims 56 and 59 are currently in condition for allowance.

**Claim 60 Patentably Distinguishes Over the Combination of Skinner, Paine, and Phelan.**

Claim 60 depends from claim 59 which in turn depends from independent claim 1. Accordingly, claim 60 is patentably distinct from the combination of Skinner, Paine, and Phelan for at least the same reasons provided above distinguishing claim 1 from Skinner and claim 59 from the combination of Skinner and Paine. Based at least on the

foregoing, the Applicant respectfully submits that claim 60 is currently in condition for allowance.

### CONCLUSION

For the reasons detailed above, it is submitted that all claims remaining in the application (Claims 1-21, 23-52, and 55-60) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

☒ Remaining Claims, as delineated below:

(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT LESS HIGHEST NUMBER PREVIOUSLY PAID FOR		(3) NUMBER EXTRA
TOTAL CLAIMS	57	-57 =	0
INDEPENDENT CLAIMS	5	- 6 =	0

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time. The appropriate fee for a petition for a 1-month extension of time associated with this submission of Amendment is being paid by credit card via the EFS Web concurrent with this submission.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Alan C. Brandt, at Telephone Number (216) 363-9000.

Respectfully submitted,

FAY SHARPE LLP



Alan C. Brandt, Reg. No. 50,218  
The Halle Building – Fifth Floor  
1228 Euclid Avenue  
Cleveland, OH 44115  
216-363-9000

February 27, 2010  
Date